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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,597	05/03/2002	Audrey Goddard	P3230R1C001-168	2713
20995	7590	06/27/2006		EXAMINER
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			WEGERT, SANDRA L	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/063,597	GODDARD ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Sandra Wegert	1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 April 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 May 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/11/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____.                                   |

**Detailed Action**

***Status of Application, Amendments, and/or Claims***

A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. This application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid.

The Response, Information Disclosure Statement, and Amendments, submitted 11 April 2006, have been entered. Claim 6 is canceled.

Claims 1-5 are under examination in the Instant Application.

The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.

**Maintained/New Objections and/or Rejections**

***35 U.S.C. § 101/112, first paragraph-, Lack of Utility, Enablement.***

Claims 1-5 are rejected under 35 U.S.C. 101, as lacking utility. The reasons for this rejection under 35 U.S.C. § 101 are set forth at pages 2-9 of the previous Office Action (9 January 2006). Claims 1-5 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth in the previous Office Action (9 January 2006),

one skilled in the art clearly would not know how to use the claimed invention.

Applicants argue (*Remarks*, 11 April 2006, page 6 and throughout) that the data presented in the instant Specification are enabling for the antibody that binds the polypeptide of SEQ ID NO: 90. They argue that the PRO1268 nucleic acid is a diagnostic marker for kidney tumor, and point to the results of the assay which showed transcription of the PRO1268 DNA in one normal versus cancerous tissue. Applicants point out that the PRO1268 data of Example 18 refers to pooled transcription data (*Response*, page 9 and throughout).

Applicant's arguments (11 April 2006) have been fully considered but are not found to be persuasive for the following reasons:

In the instant case, the specification provides data showing an indeterminate increase in mRNA in one cancerous tissue (see Example 18, Specification). However, there is no evidence regarding whether or not PRO1268 polypeptide levels are also increased in the cancerous tissue versus normal tissue. Furthermore, as discussed in the previous Office Action (11 April 2006, pages 4 and 5), what is often seen is a *lack* of correlation between mRNA levels and increased peptide levels (Pennica, et al, 1998, Proc. Natl. Acad. Sci., 95: 14717-14722). As discussed by Haynes et al (1998, Electrophoresis, 19: 1862-1871), polypeptide levels cannot be accurately predicted from mRNA levels, and that, according to the results presented, the ratio varies from zero to 50-fold (page 1863). The literature cautions researchers against drawing conclusions based on small changes in transcript expression levels between normal and cancerous tissues. For example, Hu et al. (2003, Journal of Proteome Research 2: 405-412) analyzed 2286 genes that showed a greater than 1-fold difference in mean expression level between breast cancer samples and normal samples in a microarray (p. 408, middle of right column). Hu et al.

discovered that, for genes displaying a 5-fold change or less in tumors compared to normal, there was no evidence of a correlation between altered gene expression and a known role in the disease. However, among genes with a 10-fold or more change in expression level, there was a strong and significant correlation between expression level and a published role in the disease (see discussion section).

Applicants also discuss *Nelson v Bowler* (206 USPQ 881, 1980) as support for the contention that their invention has a substantial utility (page 7, 11 April 2006). However, the case of *Nelson v Bowler* only contemplates the degree of certainty required of experimental evidence submitted in support of a contended utility and that, furthermore, the data need not point to treatment of human diseases. The Court ruled that a showing of practical utility for a composition may be satisfied by an adequate showing of any pharmacological activity, without a showing of direct therapeutic utility. Thus, the identification of some specific pharmacological activity of a compound that is relevant to an asserted pharmacological use provides an "immediate benefit to the public" and thus satisfies the utility requirement. See MPEP 2107 (III). The conclusions are that an invention need not have a therapeutic value, and the applicant need not prove that the utility is true "beyond a reasonable doubt." As discussed above, the instant specification does not suggest a specific function for the claimed polypeptide- indeed the disclosed polynucleotide and claimed polypeptide were not specifically identified at filing- so the believability of submitted evidence is not a critical issue in patentability of the claimed polynucleotide.

As the Utility Guidelines (Federal Register, 2001, 66: 1092-1099) say in the discussion of *Fujikawa v Wattanasin*, "where a class of proteins is defined by common structural features, but

evidence shows that the members of the class do not share a specific, substantial functional attribute or utility, despite having structural features in common, membership in the class may not impute a specific or substantial utility to a new member of the class. When there is a reason to doubt the functional protein assignment, the utility examination may turn to whether or not the asserted protein encoded by a claimed nucleic acid has a well-established use. If there is a well-established utility for the claimed protein and the encoding nucleic acid, the claims would meet the requirements for utility under 35 U.S.C. 101. If not, the burden shifts to the applicant to provide evidence supporting a well-established utility. *There is no per se rule regarding homology, and each application must be judged on its own merits.*" (Italics added).

Given the small increase in transcription of PRO1268 DNA, and the evidence provided by the current literature, it is clear that one skilled in the art would not assume that a small increase in message would correlate with significantly increased polypeptide levels. Further research needs to be done to determine whether the small decrease in PRO1268 message supports a role for the peptide in detecting or treating cancerous tissue; such a role has not been suggested by the instant disclosure. And, since there has been no substantial or specific function demonstrated for the polypeptide of SEQ ID NO: 90, it would not be useful to use an antibody to identify or localize the polypeptide. The requirement for further research makes it clear that the asserted utility is not yet in currently available form, i.e., it is not substantial. This further experimentation is part of the act of invention and until it has been undertaken, Applicant's claimed invention is incomplete. As discussed in *Brenner v. Manson*, (1966, 383 U.S. 519, 148 USPQ 689), the court held that:

"The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention

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with substantial utility”, “[u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field”, and,

“a patent is not a hunting license”, “[i]t is not a reward for the search, but compensation for its successful conclusion.”

Accordingly, the Specification’s assertions that the claimed PRO1268 antibody has utility in the fields of cancer diagnostics and cancer therapeutics are not substantial.

There is no evidentiary support that PRO1268 is involved in the etiology of cancer in the one sample disclosed in the instant Application. Furthermore, as noted above, the increase in PRO1268 message, and in only one tissue, points away from its role in a disease. At any rate, one result is too little data to make a conclusion about PRO1268 and cancer. It should be noted that the *specific* function of the PRO1268 polypeptide has not been disclosed by Applicants or by recent research. Although transductional and structural information are not absolutely necessary when applying for a patent on a new protein, it would be very useful to have such information for the PRO1268 polypeptide, since there is only one positive data point in the transcription assay, and that is in one tumor tissue. Finally, it is noted that the literature cautions researchers from drawing conclusions based on small changes in expression levels between normal and cancerous tissue. See Hu et al. (2003, Journal of Proteome Research 2:405-412) as discussed above.

Applicants discuss (Response, 11 April 2006, page 9 and throughout) points from case law in reference to the utility rejection, most of which the examiner agrees with. However, the fact patterns of the cases cited have little connection with utility/enablement as applied to the instant Application. Whatever the asserted specific utility might be - diagnosis of cancer, for

example- it is **not** "more likely than not" or true "to a reasonable probability" (Fujikawa v. Wattanasin, 1996, 93 F3d 1559, 39 USPQ2d 1895) since the increase in message was found in only one normal tissue sample.

Applicants assert that references submitted by the PTO do not support the contention that protein and mRNA are, at best, weakly correlated (Remarks, page 14). Applicant's arguments have been fully considered but are not found to be persuasive. Haynes et al. clearly state “[p]rotein expression levels are not predictable from the mRNA expression levels” (pg 1863, top of left column) and “only the direct analysis of mature protein products can reveal their correct identities, their relevant state of modification and/or association and their amounts” (pg 1870, under concluding remarks). Feroze-Merzoug et al. (Cancer and Metastasis Rev 20: 165-171, 2001) even disclose that “[t]he lack of correlation between mRNA and corresponding protein is evident even in low eukaryotic cells such as yeast. Therefore, it will be necessary to profile both mRNA and protein for a complete picture of how cells are altered during malignant transformation” (pg 168, col 1). Clearly, Haynes et al. and Feroze-Merzoug et al. indicate that mRNA levels do not predict protein levels.

Applicants discuss the paper by Wang, et al (2000, Urol Res 28: 308-315), and others, as evidence that mRNA levels predict protein levels (11 April 2006, page 15). However, in that very comprehensive paper cited, all quantitated data were measurements of expression. Furthermore, the authors performed dose-response curves that correlated the expression of two proteins to the invasiveness of the cancer cell lines. In addition, the authors identified the two proteins studied as surface proteins known to be involved in cell-to-cell interactions (and thus important to cancer invasiveness). This very comprehensive study shows a level of detail and

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uses the correlation of several kinds of data to point definitively to the role of the proteins studied in tumor invasiveness. The Wang, et al paper is indeed a good example of ways in which researchers can determine the functional role of a protein in a process such as carcinogenesis.

Applicants discuss the Declarations submitted previously under 35 USC §1.132 to explain how data were gathered, etc. For example, the Declaration from Dr. Grimaldi explains that data from several of the same tissues are pooled. This results in a difference of expression between the positive and negative tissue of 2-fold.

Applicant's arguments (11 April 2006) have been fully considered but are not found to be persuasive for the following reasons:

As discussed in the previous Office Action (9 January 2006), a 2-fold increase is not large and may be less likely to indicate disease (Hu, et al, 2003, Journal of Proteome Research 2:405-412), or may be sufficient (Applicant's Response, page 14). However, the type or magnitude of increase is not at issue in this case. All that is known about the PRO1268 peptide is that it is increased in one normal tissue sample. It cannot be determined what the function of the protein is in that tissue; certainly the tissue provides no clues. It is hard to conceive of a specific and substantial utility for a protein for which so little data or information is given.

Applicants do not know the function of the PRO1268 polypeptide. For this reason, detecting the PRO1268 mRNA or polypeptide by means of the claimed antibody has no specific function, since it is not useful to detect a protein for which a function has not yet been identified,

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and additionally might only be overexpressed in one cancer. Since the asserted utility for the PRO1268 polypeptide is not in currently available form, the asserted utility is not substantial.

### ***Conclusion***

No claims are allowed.

### ***Advisory information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Wegert whose telephone number is (571) 272-0895. The examiner can normally be reached Monday - Friday from 9:00 AM to 5:00 PM (Eastern Time). If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Brenda Brumback, can be reached at (571) 272-0961.

The fax number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLW  
21 June 2006

CHRISTINE J. SAoud  
PRIMARY EXAMINER

